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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,699	09/02/2003	David J. Brown	213828013US4	3482
25096	7590	11/16/2005	EXAMINER	
PERKINS COIE LLP			LE, UYEN CHAU N	
PATENT-SEA				
P.O. BOX 1247			ART UNIT	
SEATTLE, WA 98111-1247			PAPER NUMBER	
			2876	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

E.C.

Office Action Summary	Application No. 10/653,699	Applicant(s) BROWN ET AL.	
	Examiner Uyen-Chau N. Le	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12,22-25,27-31 and 45-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12,22-25,27-31 and 45-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Requesting Continued Examination (RCE)

1. Receipt is acknowledged of the Requesting Continued Examination (RCE) filed 11 October 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8-12, 25, 27-31, 45-47 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al (US 6,116,402) in view of Alonso (US 5282651 A).

Re claims 8-12, 25, 27-31, 45-47 and 50-55: Beach et al discloses a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers, the voucher comprising: a flexible and elongate substrate (fig. 1) in connection with a coin counting machine and configured to receive a first indicia 124a on the substrate; a second indicia 124b on the substrate; the coin counting machine provides a total value related to a plurality of randomly received coins (fig. 1); at least one of the first indicia 124a and second indicia 124b indicating a value of the voucher (fig. 1; col. 4, lines 17-39); a third indicia (e.g., 217.93) on the substrate, the third indicia being at least partially obscured by the second indicia (fig. 1).

Beach et al fails to teach or fairly suggest the second indicia is thermally responsive at an activation temperature of at least 75 degrees Fahrenheit; wherein rubbing adjacent to the mark with an object will render the mark visible; wherein the substrate includes a first surface opposite a second surface,

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wherein the first indicia is on the first surface and the second indicia is on the second surface; wherein the thermally responsive second indicia is configured to respond to human touch; and wherein the thermally responsive second indicia is configured to respond to human breath; respectively.

Alonso teaches a trading card made of a sheet of paper (col. 3, lines 55+ and col. 4, lines 61) comprises a primary indicia (i.e., the soldier 12), a secondary indicia 18 in area 16, wherein the secondary indicia becomes invisible (i.e., transparent) when applying heat to the area 16 by "rubbing between the thumb and index finger" to show a third indicia 20, which is obscured by the secondary indicia 18 (figs. 1 & 2; col. 3, line 49 through col. 4, line 60).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Alonso into the system as taught by Beach et al in order to provide Beach et al with a more secure system wherein the indicia made difficult to copy, duplicate due to the thermal responsive ink. Furthermore, such modification would assist in distinguishing counterfeit vouchers due to the color changing of the indicia upon changing the temperature, and therefore an obvious expedient.

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5. Claims 22-24 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al as modified by Alonso as applied to claim 8 above, and further in view of Silverschotz et al (US 5137304 A). The teachings of Beach et al as modified by Alonso have been discussed above.

Re claims 22-24 and 48-49: Beach et al/Alonso has been discussed above, but is silent with respect to a plurality of perforations in the substrate defining a pattern.

Silverschotz et al teaches a coupon [22, 23] having perforations 30 arranged in a binary pattern (figs. 2-4; col. 3, lines 21-56).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the perforations pattern of Silverschotz et al into the system as taught by Beach et al/Alonso in order to provide Beach et al/Alonso with a more secure system preventing the coupon/voucher from being duplicated. Furthermore, such modification would provide Beach et al/Alonso with the ability to determine which coupon has redeemed and to rapidly machine sorting of large numbers of redeemed coupons.

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Response to Arguments

6. Applicant's arguments with respect to claims 8-12, 22-25, 27-31 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited reference to Alonso has been used in the new ground of rejection to further meet the amended limitation of the claimed invention.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Shibahashi et al (US 4425161 A); Rocklin (GB 2123591 A); Hanakura (US 4854332 A); Kang (US 5789050 A); Higure (JP 10236046 A); Gregory, Jr. (US 5826915 A) are cited as of interest and illustrate to a similar structure of a voucher anti-counterfeiting method and apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Examiner
Art Unit 2876

November 12, 2005